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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,173	01/27/2000	Hideki Ito	2298/3	9525

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EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/14/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/492,173

Applicant(s)

ITO ET AL.

Examiner

Marc A Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases ‘when the film is put in hot water of 70 degrees Celsius for 5 sec’ and ‘when the film is put in hot water of 95 degrees Celsius for 5 sec’ and ‘when the film is put in hot water of 80 degrees Celsius for 5 sec’ are indefinite as it is unclear whether the film is put in hot water or not (the phrase ‘when the film is put’ is the same as ‘if the film is put in hot water’); the phrase also recites a process limitation, and will therefore be given little patentable weight. The phrase ‘when the film is formed into a label’ is indefinite as it is unclear whether a film or label is being claimed. The term ‘formed’ is also a method limitation, and thus will be given little patentable weight. For purposes of examination, it will be assumed that the phrase ‘a heat shrinkable polyester film’ means ‘a heat shrinkable polyester film for a label.’ The abbreviation ‘sec’ is indefinite as the abbreviation has not been defined.

3. Claim 7 recites the limitation "adhesive retention" in line 12. There is insufficient antecedent basis for this limitation in the claim.

4. The term "hot" in claims 7 – 29 is a relative term which renders the claim indefinite. The term "hot" is not defined by the claim, the specification does not provide a standard for

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ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

5. Claims 8 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8 – 10 recite the limitation "adhesive retention" in line 2. There is insufficient antecedent basis for this limitation in the claim.

6. Claims 13, 18, 23 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'cap sealing heat shrinkable polyester film' is indefinite as its meaning is unclear. For purposes of examination, the phrase will be assumed to mean any polyester film.

7. Claims 20 – 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase 'a preform process' is indefinite as its meaning is unclear. For purposes of examination, the phrase will be assumed to mean any process.

8. Claims 25 – 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. The phrase 'preform finish defect percentage' is indefinite, as its meaning is unclear. For purposes of examination, the phrase will be assumed to refer to any property. Correction and / or clarification is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 – 10, 13, 15, 18, 20, 23, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538).

With regard to Claims 7 – 10, 13, 18, 20, 23, 25 and 28, Fukuda et al disclose a heat shrinkable polyester film (column 6, lines 37 – 49) for making a label having a bonded portion (the film is used as a label of bottles; column 1, lines 10 – 19). Fukuda et al fail to disclose a film having a shrinkage of 10 – 40% in the main shrinkage direction when the film is put in water at 70 degrees Celsius for 5 seconds, and a film having a shrinkage of 50% or more in the main shrinkage direction when the film is put in water at 95 degrees Celsius for 5 seconds, and a film having a shrinkage of 10% or less in the direction perpendicular to the main shrinkage direction when the film is put in water at 95 degrees Celsius for 5 seconds. However, Fukuda et al disclose a film having a shrinkage of 30% or more in the main shrinkage direction when the film is put in water at 95 degrees Celsius for 5 seconds (column 6, lines 50 – 58), and a film having a shrinkage of 20% or less in the direction perpendicular to the main shrinkage direction when the

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film is put in water at 75 degrees Celsius for 5 seconds (column 6, lines 50 – 58). Therefore, the shrinkages would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the shrinkage, since the shrinkage would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Fukuda et al. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

With regard to Claim 15, the film haze is 10% (column 5, lines 13 – 24) and the thickness is 50  $\mu\text{m}$  (column 15, lines 60 – 61).

11. Claims 11 – 12, 16 – 17, 21 – 22 and 26 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Amberg et al (U.S. Patent No. 3,760,968).

Fukuda et al disclose a heat shrinkable polyester film for making a label having a bonded portion as discussed above. With regard to Claims 11 – 12, 16 – 17, 21 – 22 and 26 – 27, Fukuda et al fail to disclose a label which is formed by bonding together two opposite edges of a rectangular sheet of the film.

Amberg et al teach a label which is formed by bonding together two opposite edges of a rectangular sheet of the film (a rectangular sheet of heat shrinkable plastic material has its opposing ends overlapped and seamed; column 3, lines 54 – 67) for the purpose of conforming the label to a tight shape (column 4, lines 2 – 9).

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It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for disclose a label which is formed by bonding together two opposite edges of a rectangular sheet of the film in Fukuda et al in order to conform the label to a tight shape as taught by Amberg et al.

12. Claims 14, 19, 24 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda et al (U.S. Patent No. 4,985,538) in view of Yoshinaka et al (U.S. Patent No. 4,996,291).

Fukuda et al disclose a heat shrinkable polyester film for making a label having a bonded portion as discussed above. With regard to Claims 14, 19, 24 and 29, Fukuda et al fail to disclose a label which is a cap – sealing label.

Yoshinaka et al teach that labeling and cap sealing are equivalent as articles comprising a heat shrinkable polyester film (column 1, lines 15 – 32) for the purpose of making an article which attaches closely as a wrapping (column 1, lines 17 – 32).

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a label which is a cap – sealing label in Fukuda et al in order to make an article which attaches closely as a wrapping as taught by Yoshinaka et al.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (703) 305-3537. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If

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attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (703) 308-4251. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.

*Marc Patterson*  
Art Unit 1772

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772 8/12/02